

REMARKS

Claims 1 through 20 are pending in this application. Claims 7 and 17 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

Requirement for Restriction under 37 C.F.R. §1.141

In Paper No. 200502, the Examiner required Applicant pursuant to 35 U.S.C. §121 and 37 C.F.R. §1.141, to elect between:

- Group I: a method for manufacturing a thin film transistor, defined by claims 7-12 and 17-20, classified in class 438, at subclass 149; and
- Group II: a thin film transistor, defined by claims 1-6 and 13-16, classified in class 257, at subclass 347.

Applicant respectfully traverses the election requirement imposed in the Office action, but provisionally elects with traverse Group II defined by claims 1-6 and 13-16 and drawn to a thin film transistor.

Applicant objects to and traverses the election requirement on the grounds that the subject

matter of the groups overlap. In addition, the mandatory fields of search for the embodiments are coextensive as shown below.

As specifically stated in MPEP § 803, the examiner must show that the (A) The inventions must be independent (see MEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); **and** (B) There must be a serious burden on the examiner if restriction is required (see MPEP §803.02, § 806.04(a) -§806.04(i),§808.01(a), and § 808.02).

As shown below, the criteria of serious burden on the Examiner according to MPEP § 803 has not been met for a proper restriction requirement.

For example, in group I claims 7-12 and 17-20 is said to be drawn to a method for manufacturing a thin film transistor while group II claims 1-6 and 13-16 are drawn to a thin film transistor. However, looking at group II, claims 1-6 and 13-16 include features of group I. .

Moreover, each of the claims from group I, claims 7-12, depend on the claims from group II and the features of claim 13 of group II are included in claim 17 of group I. Clearly there is no serious burden on the Examiner.

The Examiner states that in the instant case, the product of group II can be made by another materially different process from that of the group I process. However, as mentioned above, all claims from group I, claims 7-12, depend on the claims of group II (claim 1) and claim 17 from group I includes the features of claim 13 of group II. .

Moreover, the Applicant traverses the requirement and requests re-consideration and withdrawal of the requirement, because all patents and patent applications directed to the subject matter of either Group I or Group II, by statute, must necessarily disclose out to make and use the subject matter disclosed by those patents and patent applications. Consequently, the mandatory field of search for both Group I and II are co-extensive and inherently overlapping in their disclosed details. A search confined solely to one class, without considering the classes directed to other statutory matter, is intrinsically incomplete. Consequently, the Examiner must search the designated subclasses of both class 438 and class 257. Withdrawal of the requirement is therefore requested.

Therefore, respectfully, as shown above and according to MPEP §803, it is clear that the restriction of the present reissue application is improper and creates no serious burden on the Examiner.

Moreover, according to MPEP §821.04 in the *In re Ochiai* rejoinder, when there is even a proper restriction between product and process claims and when the product claims are elected, and the product claims are allowable, the process claims that include all the limitations of the allowable product claims would also be allowable.

Therefore, since the method claims of group I include the features of the product claims of group II, when the claims of group II are allowed, the claims of group I must be rejoined according

to MPEP §821.04.

In addition, the claims of group I must be examined along with the claims of provisionally elected claims of group II because, according to MPEP §2113:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding “inter-bonded by interfusion” to limit structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations.)

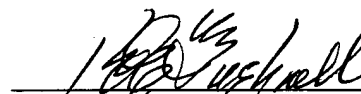
Therefore, since for example claim 7 of group I is dependent on claim 1 of group II and claim 17 of group I includes features of claim 13 of group II, the process steps must still be considered since the elements MPEP §2113 forces the Examiner to consider claim 7 and its dependent claims 8-12 and also claims 17-20.

Therefore, as mentioned above, there is no serious burden on examining the claims of group I, but furthermore, the Examiner must examine the claims of group I along with the provisionally elected claims of group II because of reasons set forth above.

In view of the foregoing election, this response is believed to be a complete response to the Requirement for Restriction. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

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